

**Notice of Allowability**

Application No.

10/614,539

Applicant(s)

SU ET AL.

Examiner

Art Unit

Zachary C. Tucker

1624

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☐ This communication is responsive to \_\_\_\_.
2. ☒ The allowed claim(s) is/are 1-14 and 16-20.
3. ☐ The drawings filed on \_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 17Dec03
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_.

**JAMES O. WILSON****SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1500**

### **EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mollie M. Yang on 31 January 2005.

#### **IN THE CLAIMS –**

In line two of claim 14, the word --compuond-- has been deleted and “compound” has been inserted therefor.

Claim 15 has been cancelled.

In line one of claim 17, the phrase --or prevention-- has been deleted. In line three of claim 17, --(interstitial cystitis)-- has been deleted.

In line one of claim 18, the phrase --or prevention-- has been deleted.

In line two of claim 19, the phrase --diabetic symptoms associated with-- has been deleted.

In line one of claim 20, the phrase --prevention of-- has been deleted.

end of amendments

***Allowable Subject Matter***

Claims 1-14 and 16-20 are allowed.

The following is an examiner's statement of reasons for allowance:

A search of the prior art afforded no disclosure which renders obvious or anticipates the compounds according to claims 1-13, thus the pharmaceutical composition of claim 14 and methods according to claims 16-20 are novel and unobvious as well.

The methods according to claims 16-20, as amended herein, are deemed enabled by the disclosure, as treatment of pain by administering a bradykinin receptor antagonist was within the level of ordinary skill in the art at the time the invention was made. Although a few non-pain related conditions are specified in the method according to instant claim 19, the claim is deemed enabled because those conditions recited in addition to pain are sufficiently narrow in scope so as to permit the method's practice without undue experimentation (arguably, however, the conditions recited in claim 19 can be characterized as painful conditions).

In an inventor name search, the co-pending application with U.S. serial number 10/614,390 was considered. This examiner is assigned case 10/614,390. Although the co-pending application presents some overlapping subject matter at least insofar as the compounds claimed therein are concerned, the instant application is being allowed to pass to issue because pursuant to the attached Examiner's Amendment, the provisional Obviousness-Type Double Patenting rejection necessitated by the co-pending application is the only outstanding issue (the Examiner's Amendment was made to correct deficiencies under the first and second paragraphs of 35 U.S.C 112). Thus, the

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examiner is allowing the instant case to pass to issue, as the MPEP directs the examiner to do in chapter 804.

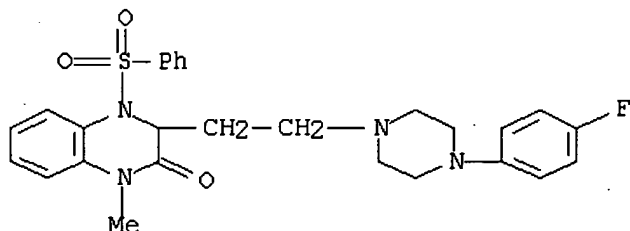
The following are notations of close prior art with respect to the compounds according to the invention:

V. D. ROMANENKO, et al., (English version - translated from): Khimiya Geterotsiklicheskikh Soedinenii, 2, pp 264-266 (1973).

Romanenko et al teaches some compounds similar to those claimed, but these lack the specific heterocyclic substitutions on the phenyl in R<sup>1</sup> of the formula (I) compounds.

JP 05331151 (Fujiwara et al).

Fujiwara et al teaches the following compound, and many close analogs thereof



as neuroprotectants for cerebral ischemia.

Neither Romanenko et al nor Fujiwara et al suggest any compound of the instant invention.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### **Conclusion**

All Post-Allowance Correspondence concerning this application must be mailed to:

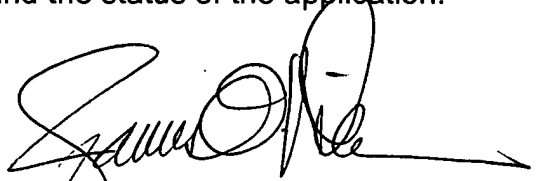
Mail Stop Issue Fee

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Or you can fax them to the Office of Patent Publications at 703-872-9306, in order to expedite the handling of such correspondence as amendments under 37 CFR 1.312; information disclosure statements, and formal drawings. Sending Post-Allowance papers to Technology Center 1600 will only cause delays in matching papers with the case.

For information concerning status of correspondence sent after receipt of the Notice of Allowance, please contact the Correspondence Branch at (703) 305-8027. The Notice of Allowance also has an insert containing contact information on other items, including Issue Fees, receipt of formal drawings and the status of the application.  
zt

A handwritten signature in black ink, appearing to read "Zach" followed by a horizontal line.A handwritten signature in black ink, appearing to read "James O. Wilson" followed by a horizontal line.

**JAMES O. WILSON**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 1600**